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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,752	06/18/2001	John Charles Kath	PC 10760A	1737
7590 12/31/2003			EXAMINER	
Paul H. Ginsburg Pfizer Inc 20th Floor 235 East 42nd Street New York, NY 10017-5755			BERCH, MARK L	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 12/31/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/883,752

Applicant(s)

KATH ET AL.

Examiner

Mark L. Berch

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 16 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See memo.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,4-16 and 21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Mark L. Berch
Primary Examiner
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DETAILED ACTION

The traverse of the 103(a) rejection is unpersuasive. It is agreed that the reference is available only under 102e. Applicants refer to MPEP 706.02k, but that deals with a provisional rejection over an application, not the circumstance here. Correct is 706.02(l), and specifically, 706.02(l) (2) (II), which states, "The common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. In re Onda, 229 USPQ 235 (Comm'r Pat. 1985)." The MPEP gives as an example, "...the attorney or agent of record for Application X states, in a clear and conspicuous manner, that: "Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z." This statement alone is sufficient evidence..." This standard applicants have not met because it does not refer to "at the time the later invention was made". The remarks actually state, "the instant application and the 1764 patent are subject to an obligation of assignment to the same person, i.e., Pfizer Inc." The fact that they "are subject" does not necessarily mean that they were at the earlier time. Thus, while applicants refer to the "exemption provided for commonly owned prior art under 35 U.S.C. 102(e)" that quote does not have the limitation "at the time the later invention was made". A proper statement will overcome the rejection.

The traverse of the obvious-type double patenting rejection is unpersuasive. It appears that an impasse has been reached on this issue. The examiner has provided a detailed analysis. In these circumstances, the same analysis is appropriate for both the 103 and the obvious-type double patenting rejection. Applicants state, "The test for double patenting of the obviousness type is whether the later claim defines an obvious

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variation of the earlier claim. In re Emert, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997).” That is correct. That decision stated that one examines, “the application claim for patentable distinctiveness from the patent claim.” But in this case, the claim has the same scope as what is in the specification. The claim is no narrower than the specification. Indeed, one of the species which the examiner pointed to, example 76, is the 7th species recited in claim 13. Applicants also cited Quad Envtl. Tech. Corp. v. Union Sanitary Dist., 20 USPQ2d 1392, 1394 (Fed. Cir. 1991). That decision states, “Only the claims are compared in a rejection for double patenting”. That is what the examiner is doing, comparing the claims. It is correct that one cannot do an obvious-type double patenting rejection against unclaimed subject matter in a patent, but that is not what the examiner is doing, since the material appears in the claims as well. Thus, the Final Rejection states, “That precise equivalency is taught at column 59, line 59, with the term Heterocycle-(CR¹R²)_q-O-. Note that q can be 0-5 as seen at lines 62-63.” That is material in the claims - - column 59 is claims text. Thus, it is not just a matter of an “obvious variation” - - the q = 0 material, i.e. the subject matter of the instant claims, is in the claims of the patent. Applicants already have a patent on this pyridyloxy subject matter, and now seek a second patent on this pyridyloxy subject matter. Thus, there is no need for the examiner to provide “motivation” to get to an “obvious variation” - - the material is already in the claim of the patent, and thus no variation is to be done.

The traverse of the enablement rejection is unpersuasive. Applicants state, “With respect to the Examiner's position that the compounds of the claimed invention do not form solvates the only proffered evidence is the lack of a particular solvate example in the specification of the subject application and the Examiner's statement that all

attempts to prepare solvates failed. Applicants are at a loss for the basis of this statement by the Examiner. On what basis is the Examiner concluding that all attempts to prepare solvates failed'. The Examiner is making a finding without any underlying support for such a position." Applicants are at a loss because they are not facing what the application shows. Solvates are formed by exposing the compound to the appropriate solvent. If the compound is capable of forming a solvate, then it will form a solvate; if it is not capable, then it does not form a solvate. Here, the hundreds of examples presented all failed to produce a solvate. This is not the examiner's "personal statement", it is an objective recitation of the facts of this specification.

Instead of dealing with the facts here, applicants talk about other compounds. Yes, it is routine for compounds to form solvates, just as it is routine for compounds to not form solvates. The fact that some compounds form solvates does not mean that applicants compounds form solvates, any more than the fact that some compounds have an odor means that applicants' compounds have an odor. Applicants state, "Preparation of solvates of compounds is well known and understood by those of ordinary skill in the art." One of ordinary skill in the art knows that the method is to expose them to the solvent. Applicants traverse goes on for pages, yet they do not present a single sentence describing how they actually plan to make the solvates, given the fact that in the hundreds of examples, the only known method --- exposing the compounds to the solvent -- did not, in fact, yield solvates.

In this regard, Applicants state, " Applicants respectfully request the Examiner identify what rule, case law or precedent he is relying on to support his statement on page 7 of the Office Action: "[h]ence, applicants must show that solvates can be made."

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MPEP 2164.05 states, "Once the examiner has weighed all the evidence and established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on applicant to present persuasive arguments, supported by suitable proofs where necessary" that the claims are indeed enabled. The reasonable basis here is fact that the only known method for making solvates did not, in the hundreds of examples in this case, actually produce a solvate. The specification does not teach any other methods aside from simple exposure to the solvent, and the examiner knows of no other methods. Therefore, the burden has been shifted to applicants, and the remarks have not suggested any other methods. The fact that a patent application can be filed with "only prophetic examples" is beside the point. Had there been no actual examples, then the examiner would have had no evidence, and the burden would not have shifted to applicants. Such was not the case here.

Applicants analysis of Morton entirely misses the point. In that case, the court said that "the examples and procedures produce a complex mixture of alkyltin mercaptides and alkyltin sulfides" instead of what the claims called for, viz., esters. The same is true here. The claims call for solvates, and despite the fact that the reaction were run under the only conditions known to produce a solvate, i.e. doing the reaction in a solvent, solvates were not prepared. Instead, applicants resort to stating, "The preparation of solvates in the instant application is merely the preparation of additional compounds well within the scope and skill of those of ordinary skill in the art." But how is this preparation, which the sentence referred to, to be done? Applicants keep saying that one of ordinary skill in the art knows how to do it, but the method that one of

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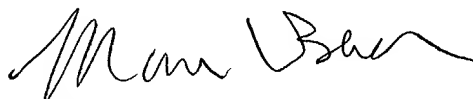
ordinary skill in the art knows is the very method that, with these particular compounds, did not result in the synthesis of solvates.

The objection to claim 4 is taken care of.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
Art Unit 1624

12/19/03